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REMARKS/ARGUMENTS

Claims 1 - 57 are pending in the application. Claims 1 - 6, 8 - 14, 17, and 20 - 24 are rejected. Claims 27 - 57 have been withdrawn subject to a restriction requirement and are cancelled herein. Claims 1, 20, and 26 are amended, and claims 9, 24, 25, and 27 - 57 have been cancelled herein. All rejections are addressed below.

Rejection of Claims 1 - 6 and 11 - 14 under 35 U.S.C. §102(b) in view of Bayless '555

Claims 1 - 6 and 11 - 14 stand rejected under 35 U.S.C. 102(b) as being anticipated by Bayless 5,464,555. The Bayless reference discloses a graphic ink remover composition. According to the Office Action, the ink remover composition contains amounts of C₁ to C₄ esters of lactic acid (ethyl lactate), surfactant (including alcohol alkoxylates), and solvent (d-limonene and n-methyl pyrrolidone).

Independent claim 1 has been amended (claims 2 - 19 are amended by dependency) to recite that the solvent used in the invention is selected from water, methanol, ethanol, and isopropanol. Bayless fails to disclose that the solvent used is selected from water, methanol, ethanol, and isopropanol. Therefore, claims 1 - 6 and 11 - 14 are not anticipated by Bayless.

The solvents disclosed in Bayless are d-limonene (col. 2, lines 42-43), N-methyl pyrrolidone (NMP) (col. 2, lines 48-49), ethyl lactate (col. 2, line 63), and methyl lactate (col. 3, line 6). Further, Bayless specifies that the disclosed composition is non-aqueous (abstract). D-limonene and NMP are both cyclic compounds, and the lactates are carboxylic acids. One of ordinary skill in the art would not be motivated by the reference to substitute water, methanol, ethanol, or isopropanol for the solvents disclosed in Bayless because those solvents are chemically dissimilar from the Bayless solvents and Bayless provides no motivation to use solvents other than those explicitly recited in the reference. Further, to the extent that water, methanol, ethanol, and isopropanol are equivalent for use as a solvent in the claimed invention, the Bayless reference teaches away from the use of the claimed solvents by specifically stating that the Bayless composition is non-aqueous. Therefore, claims 1 - 6 and 11 - 14 are not obvious in view of Bayless.

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Rejection of Claims 1 – 6, 8 – 12, and 17 under 35 U.S.C. §102(e) in view of Opre '720

Claims 1 – 6, 8 – 12, and 17 stand rejected under 35 U.S.C. 102(e) as being anticipated by Opre 6,284,720. According to the Office Action, the Opre reference discloses an ink cleaning preparation that contains an ester of lactic acid, a surfactant, and uses alcohol as a solvent. However, Opre also contains 1 – 30 wt% of a fatty acid ester that is not used in the claimed composition.

Claim 1 (and claims 2 – 6, 8 – 12, and 17 by dependency) recites a composition comprising an ester acid composition consisting essentially of at least one C₁ to C₄ ester of lactic acid. The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps and those that do not materially affect the basic and novel characteristics of the claimed invention. MPEP 2111.03.

Applicant submits that the fatty acid esters disclosed by Opre would materially affect the basic and novel characteristics of the claimed invention. The fatty acid esters are relatively long chain esters (C₁₆ – C₂₀) in comparison to the lactic acid esters, and would therefore be expected to have different chemical properties. Further, logic suggests that Opre specified the combined use of both fatty acid esters and lactic acid esters because the reference expected the composition to exhibit materially different characteristics with the combination compared to lactic acid esters used alone. Because the “consisting essentially of” language of claim 1 excludes ester acids other than C₁ – C₄ esters of lactic acid, and because the fatty acid esters disclosed in Opre would materially affect the basic characteristics of the claimed composition, claims 1 – 6, 8 – 12, and 17 must be read to exclude the fatty acids. Thus, the claims are not anticipated by Opre.

Whereas the reference clearly distinguishes lactic acid esters and fatty acid esters on the basis of composition and characteristics (col. 4, lines 26 – 38 and lines 39 – 59) and whereas the reference provides no motivation to remove the fatty acid esters from the composition of the reference, one of ordinary skill in the art would not be motivated to remove the fatty acid esters from the reference composition in an attempt to obtain the claimed invention. Therefore, the composition of claims 1 – 6, 8 – 12, and 17 is nonobvious in view of Opre.

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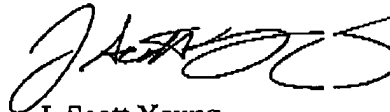
The limitations of claim 25 have been incorporated into independent claim 20, claims 24 and 25 have been cancelled, and claim 26 has been amended to properly depend from claim 20. Whereas the recitations of claim 25 (objected to only as depending from a rejected base claim) have been incorporated into independent claim 20, and whereas claims 21 - 23 and 26 each incorporate such recitations by dependency from claim 20, Applicant submits that claims 20 - 23 and 26 are now in condition for allowance.

Conclusion

In view of the above amendments and remarks, it is submitted that the claims are in condition for allowance. Such action is respectfully requested.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

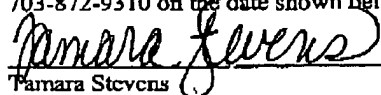


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